

### REMARKS

Applicants have amended claim 1. Support for the amendments can be found, e.g., in the originally-filed specification at ¶ [0076]. Claims 7-15 are withdrawn. Claims 1-6 and 16-17 are presented for further examination.

#### Election Requirement

Applicants confirm the election, without traverse, to prosecute the invention of group I, claims 1-6 and 16-17.

#### Double Patenting

The Office action provisionally rejected claims 1-6 and 16 and 17 on the ground of nonstatutory obviousness-type double patenting as unpatentable over claims 1-7, 16 and 17 of copending U.S. Application Ser. No. 10/599,128. A terminal disclaimer is filed herewith to obviate this rejection.

#### Claim Rejections Under 35 U.S.C. § 112

The Office action rejected claim 1 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants have amended claim 1 and respectfully request that the rejection be withdrawn.

#### Claim Rejections Under 35 U.S.C. §§ 102 and 103

The Office action rejected claims 1-6 and 16-17 under 35 U.S.C § 102(b) as a anticipated by, or in the alternative, unpatentable over U.S. Patent No. 6,103,117 (Shimagaki et al.). Applicants respectfully disagree with the conclusion of unpatentability, particularly in light of the amendments to claim 1.

As an initial matter, Applicants disagree with the Office action's "claim interpretation," which suggests, *inter alia*, that the Examiner is not giving due consideration to functional language in the claims. *See* Office action at p. 6. Generally speaking, Applicants are given

discretion to choose the manner in which to claim their inventions. As the MPEP states, "Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought." MPEP § 2173.01. The MPEP goes on to reiterate that "[t]here is nothing inherently wrong with defining some part of an invention in functional terms" and a "functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." MPEP § 2173.05(g).

The permselective separation hollow fiber membrane bundle according to claim 1 includes the following features:<sup>1</sup>

Feature (1):

a polysulfone permselective hollow fiber membrane bundle which contains poly(vinylpyrrolidone);

Feature (2):

which shows a hydrogen peroxide-eluting amount of 5 ppm or less, when the following procedure is conducted: to an eluate (2.6 ml) obtained by an eluation test regulated in the Approval Standard for Dialysis-type Artificial Kidney Apparatus is added a solution mixture of a hydrogen chloride solution of  $\text{TiCl}_4$  mixed with an ammonium chloride buffer (pH 8.6) (0.2 ml) equivalent in molar ratio and an aqueous solution of a Na salt of 4-(2-pyridilazo)resorcinol; further, a 0.4 mM coloring reagent (0.2 ml) is added, and the resulting mixture is heated at 50°C for 5 minutes, and then is cooled to room temperature; and the absorbance of the resultant solution is measured at a wavelength of 508 nm.

The Shimagaki et al. patent fails to disclose at least feature (2). Indeed, it is completely silent. Accordingly, the Shimagaki et al. patent fails to anticipate claim 1, and does not render

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<sup>1</sup> Applicants have parsed claim 1 into these two "features" solely for ease of reference.

obvious the claimed subject matter. Dependent claims 2-6 and 16-17 recite additional features and are independently patentable.


Conclusion

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

The terminal disclaimer fee of \$140.00 is being over the EFS by way of deposit account authorization. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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Samuel Borodach  
Reg. No. 38,388

Fish & Richardson P.C.  
Citigroup Center  
52nd Floor  
153 East 53rd Street  
New York, New York 10022-4611  
Telephone: (212) 765-5070  
Facsimile: (877) 769-7945